REMARKS

The Amendments

Claim 1 is amended to incorporate the substance of claim 21 therein. Claim 21 and analogous claims are accordingly canceled.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments merely incorporate the substance of a dependent claim into the main claim. Since the incorporated dependent claim has previously been subject to the examination here, the amendment does not raise new issues or present new matter. Further, no additional claims are presented. The amendments have been made to address the allegation first made in the Final action that the comparative data presented in the Declaration under 37 CFR §1.132 is not commensurate in scope with the claims. Thus, the amendment was not earlier presented. Accordingly, it is submitted that the requested amendment should be entered.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction Requirement

Applicants maintain their traversal of the restriction requirement and urge that it should be withdrawn. There is insufficient basis on the record to support restriction of the method of use claims.

Initially, it is noted that restricted claim 56 is a composition claim, not a method of use claim, thus it is not part of the restricted claims and is not indicated as withdrawn.

As for the method of use claims, applicants maintain their traversal of the restriction for the reasons they originally set forth. The Office action alleges that the method as claimed -- allegedly broadly male contraception -- can be practiced with a materially different product such as a condom. But applicants are not claiming any method of male contraception. The method as claimed requires action of the recited active component in the composition. Clearly use of a condom does not achieve the method as claimed. Merely achieving a same or similar ultimate result does not mean that the claimed invention is achieved. Clearly, the results are achieved in very different ways. If the way of achieving the result is irrelevant, what is the point in having any standards for determining if a restriction is necessary? The PTO's own manual sets forth that there are standards for supporting restriction and applying the standard as has been done here to allege restriction eviscerates these standards required by the PTO's own practice manual. If the restriction is to be maintained, applicants urge that an explanation be given why the PTO's own guidelines – not to mention legal precedent – do not apply to the instant case. Otherwise, the basis for the restriction alleged here does not meet the PTO's burden of proof and the restriction should be withdrawn.

Applicants also urge that, should the composition claims be found allowable, the method claims will be subject to rejoinder. Reference is made to the decisions in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), and In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996). The Commissioner's comments thereon in 1184 TMOG 86, March 26, 1996, indicate that where product and process claims in the same application have been restricted and the elected product

claim has been found allowable, withdrawn process claims including the limitations of the allowed product claim will be rejoined into the application and fully examined in that same application. If the restriction is not withdrawn, the method of use process claims herein should be rejoined and fully examined at such time as the product claim is found allowable.

The Rejection under 35 U.S.C. §103

The rejection of claims 1, 3, 5-6, 21-25 and 29-37 under 35 U.S.C. §103, as being obvious over WO 95/12383 in view of Riffkin (J.Pharm.Sc.), is respectfully traversed.

Applicants remain of the opinion that the cited prior art fails to render the claimed invention prima facie obvious. Applicants' arguments on this point are provided below. However, even if a prima facie case of obviousness were supported, applicants urge that the record supports a clear and convincing showing of nonobviousness for the instant claims. Applicants previously submitted a Declaration under 37 C.F.R. §1.132 showing the unexpected advantages of applicants' invention. In the Final Office action, the showing was said to be not convincing. It was alleged that, because applicants compared only one castor oil concentration within the instant claims, the showing was not commensurate in scope with the claims. Applicants respectfully disagree. The law does not support that a showing of only one embodiment means the showing is necessarily not commensurate in scope with the claims. The law and PTO guidelines only require that the showing be reasonably representative of the advantage(s) of the claimed invention over the cited prior art; see, e.g., In re Kollman, 201 USPQ 193 (CCPA 1979); In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980); and MPEP §2145. There is no basis to conclude, merely from the fact that only one embodiment is shown,

that the showing cannot be commensurate and, thus, not convincing. In the instant case, the prior art discloses and directs one skilled in the art only to compositions with amounts of castor oil well above the maximum amount recited by the instant claims. Thus, the only embodiment of relevance for comparison is one representative of the maximum range of the recited claims. If the data show unexpected advantages for the high end of the claimed range, this is sufficiently representative of the full scope of the claims because the low end of the claimed range is even further removed from the prior art teachings. The showing in the declaration of the clear and significant advantages of the embodiment having 37% castor oil (see further discussion below), is reasonably representative of the maximum of the claimed range, i.e., 40%. The showing of the advantage at 37% would be expected to be indicative of the advantage at 40% as well, compared to the 50% minimum of the prior art. The standard is a "reasonable" one – see above citations – not a strict one and the 3% difference is within the range of reasonableness. In view of this discussion and the amendment to the claims above, it is urged that the data (discussed in detail as follows) be reconsidered for its showing of nonobviousness.

The previously submitted Declaration under 37 C.F.R. §1.132 provides a side-by-side comparison of the stability of compositions according to the claimed invention with compositions otherwise the same but having higher amounts of castor oil, such as taught by Riffkin. Multiple ampoules of compositions containing testosterone undecanoate, benzyl benzoate and castor oil were tested side-by-side for stability (lack of precipitate crystals) over 34 days. One set of ampoules contained 60% castor oil, one set 50% and one set 37%. All of the ampoules which contained 37% castor oil (63% benzyl benzoate) – and thus are representative of the claimed invention – maintained stability with no precipitate for the full 34 days. For the

compositions which contained 50% – the lowest range suggested by Riffkin – and 60% castor oil, most of the ampoules lost stability before 34 days.

The advantage in stability of the compositions, when using a lower amount of castor oil as recited in the instant claims, could not have been expected from the prior art. Neither reference teaches any advantage in stability for its compositions. Further, to the extent Riffkin suggests to use castor oil in the WO '383 compositions, it only suggests to use such in amounts of 50% or higher. Thus, the advantage in stability of the solutions for applicants' invention using a lower amount of castor oil was clearly unexpected over the prior art teachings. This unexpected advantage provides further clear and convincing proof of the nonobviousness of applicants' invention. The declaration also provides comparisons of castor oil to peanut oil and miglyol solutions. These comparisons clearly show that castor oil is advantageous over these other oils. Thus, the comparison also shows the advantage in stability of the solutions of the claimed invention using castor oil over those having the first-listed preferred oil of WO '383, i.e., peanut oil. These advantages discovered by applicants were discussed in applicants' specification (page 10, lines 24-33):

> The compositions of the invention are chemically stable with respect to the testosterone esters. That is to say that degradation products could not be detected after long term storage (such as after 7 weeks or 17 weeks or even longer) at conditions normally known to accelerate degradation processes, such as variations in temperatures, high and low temperatures and various relative humidity. For example, less than 1% by weight of degradation products of testosterone esters is present after storage of the composition for at least 7 weeks, such as for 16 or 17 weeks, for 6 months, or for 9 or 12 months at 40 °C and 25 % RH in darkness. Preferably, less than 0.5 % w/w, such as less than 0.2 % w/w of degradation products of testosterone esters is present after storage at the above-mentioned conditions.

The references do not teach or suggest anything regarding such the advantageous stability properties. Thus, the advantages are clearly unexpected from the prior art and provide a clear and convincing case for nonobviousness. For this reason, at least, the rejection under 35 U.S.C. §103 should be withdrawn.

Applicants further submit that the references fail to support a prima facie case of obviousness in the first instance or, alternatively, that any such case is a weak one which makes the showing of nonobviousness even more convincing.

WO '383 discloses an injectable solution of testosterone undecanoate with an injectable plant oil and/or benzyl benzoate. WO '383 provides no suggestion to use castor oil as the plant oil in its compositions. To the contrary, at page 4 of the publication, WO '383 recites the possible use of peanut, soy, sesame, tea or olive oils. WO '383 also provides no suggestion as to the relative amounts of the plant oil and benzyl benzoate. Particularly, there is no suggestion of a composition of testosterone undecanoate containing an amount of castor oil as recited in the current claims, i.e., castor oil in a concentration of 25 to 40% by volume.

The Office action alleges that it would have been obvious to one of ordinary skill in the art to modify the teachings of WO '383 in view of Riffkin since Riffkin teaches the use of a vehicle having castor oil and benzyl benzoate in relative amounts of 1:1 (50:50) or 65:35 for delivering steroidal compositions parenterally. Riffkin discusses the use a combination of castor oil and benzyl benzoate as a vehicle for steroid hormones generally. However, Riffkin discloses no such combination of a vehicle with a testosterone ester. Riffkin discloses 9 examples of vehicles with castor oil and benzyl benzoate. In these vehicles the amount of castor oil ranges from 50 to 80%, i.e., well above the 40% maximum recited in the instant claims.

Applicants respectfully submit that one of ordinary skill in the art would not have been motivated or otherwise had a reason to modify the compositions of WO '383 to provide a composition meeting the requirements of the instant claims. If one of ordinary skill in the art were to modify the WO '383 compositions in view of Riffkin, they would use castor oil as the plant oil in an amount of 50-80% in the composition according to Riffkin's teachings. Such a composition would not meet the recitations of the instant claims, i.e., a vehicle comprising castor oil in a concentration of 25 to 40% by volume. There are no other suggestions from the cited references to provide a composition, as claimed, having this amount of castor oil.

It is alleged in the Final office action that "optimization of the amount of excipients is considered obvious as being within the purview of the skilled artisan."

However, there is no factual basis on the record to support that lowering the amount of castor oil would result in some optimization. In order to support obviousness to modify an amount of a component in a composition for purposes of optimization, there must be some basis provided on the record that the modification of the amount would optimize some aspect of the composition. There is no basis to assert such here. The Office action merely alleges optimization but indicates no objective for such optimization or what aspect is intended to be optimized. Further, no reference of record provides any support that lowering the castor oil amount would optimize the composition in any way. To the contrary, the only teachings of record regarding an amount of castor oil come from Riffkin which teaches a range of 50-80%. Since Riffkin clearly pointed one of ordinary skilled in the art to this amount range, the only reasonable conclusion such skilled artisan could draw from the record here is that 50-80% is the optimal range and other amounts would, therefore, be less than optimal. There is certainly no

direction from the cited prior art that lowering the amount of castor oil would lead to optimization or what property would be optimized. The only suggestion of this comes from applicants' own teachings and data.

Additionally, no basis in the law is cited for the proposition that "optimization of the amount of excipients is considered obvious as being within the purview of the skilled artisan." The context of the statement in the Office action and the failure of any factual support for it, leaves the impression that it is allegedly per se obvious to modify the amounts of a reference composition to achieve some undefined "optimization." If this is what is being alleged, it is clearly contrary to the law. Lacking any evidentiary support, the alleged general optimization argument is merely a conclusory statement of the type the Supreme Court recently cautioned against use to support an obviousness rejection; see, KSR International Co. v. Teleflex Inc., 550 U.S. _, 82 USPQ2d 1385, at 1396 (2007), stating: "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." A general statement that some undefined optimization would be expected is not a sufficient rational underpinning to support the rejection.

For all of the above reasons, it is urged as a separate basis for patentability that the cited references fail to establish a prima facie case for obviousness. Thus, the rejection under 35 U.S.C. §103 should be withdrawn for this additional reason.

For all of the above reasons, it is urged that the combined teachings of WO '383 in view of Riffkin, particularly when considered in light of the declaration evidence of nonobviousness, fail to render the claimed invention obvious to one of ordinary skill in the art. Thus, the rejection

under 35 U.S.C. §103 should be withdrawn.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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